REMARKS

[01]   Reconsideration of the present application is respectfully requested in view of the comments submitted herein and the amendments to the claims.

[02]   Applicant thanks the Examiner for the thorough examination of the present application and the detailed Office Action.

[03]   <u>INFORMATION DISCLOSURE STATEMENT</u>

[04]   In response to the Examiner's request, Applicant submits the referenced magazine "BUSINESS 2.0"(see reference to SaveThis.com on page 26) and a copy of the web site page from www.savethis.com in Form PTO-1449 as of 6/28/2004.

[05]   <u>CLAIM OBJECTIONS</u>

[06]   In claims 7 and 8, Applicant has amended the claims to correct the informalities, i.e. the misspelling of "through." Approval is requested.

[07]   <u>CLAIM REJECTIONS UNDER 35 USC SEC. 102</u>

[08]   Claims 1-7, 10-11 are rejected by the Examiner under 35 USC Sec. 102 (e) as being anticipated by Drucker et al. ("Drucker"), US Patent No. 6,292,796. Applicant respectfully traverses the Examiner's rejection, because the Examiner has not established a *prima facie* case of anticipation, as further explained below.

[09]   <u>Brief Summary of the Invention</u>

[10]   The present invention is about "clipping" newspaper or magazine articles, and actually the improvement thereof by virtue of modern technology. The invention is directed to a method and system of enabling readers of <u>printed publications</u>, such as newspapers or magazines, to easily retrieve and handle a printed article, which has been printed on a hardcopy newspaper with a unique tag printed with it. Conventionally, upon reading an article on a printed newspaper, a reader may want to either save the printed article (traditionally called "clipping") for future reference, or forward the printed article to friends or colleagues. However, the conventional way of "clipping" from a printed newspaper is not very conducive, nor efficient, since the printed article, in hardcopy, must first be "clipped" from the physical newspaper, before any further action can take place, such as copying, faxing or saving in a file. As any administrative assistant can

vouch, clipping a printed article from a printed newspaper is a tedious and time-consuming task, since the article may span several pages, and may require some trimming in order to fit on a standard sheet of paper suitable for copying or faxing.

[11]   The present invention makes "clipping" much easier and efficient by taking advantage of the global computer communication networks, commonly known as the Internet. Prior to an article's publication in a printed newspaper or magazine, the article is pre-assigned a unique tag. When the article is published in printed; the unique tag is also published, for example, appended to the end of the article. When a reader of the printed publication desires to save the article he is currently reading for future reference, or forward it to his colleagues, the reader simply enters the unique tag in a designated web site. Upon receiving the request, the web server will retrieve the article, in its electronic format, based on the unique tag, and electronically transmits the article, still in electronic format, to the reader's email in-box. After the reader obtains the electronic article, any subsequent action, e.g. saving to the PC, e-mailing to a colleague, or printing out the hardcopy, becomes so much easier and efficient. There is no more need to physically "clip" the article from the newspaper, "trimming" the cut-out for copying, or faxing the copy. Additionally, since the article can now be stored in electronic format, it can be stored in the PC's hard drive, without taking up additional physical space in the reader's room or office.

[12]   The present invention does more than just providing a clipping; it also offers a potential revenue stream for the newspaper publisher. When the article is transmitted to the reader's e-mail in-box, additional information, related to the subject matter, may be bundled with the transmission. One form of bundling involves related articles, while the other form of bundling can include advertisements for products or services related to the subject matter of the article. With the advertisements, newspaper publishers can generate revenue from articles that lose their value over time.

[13]   The Drucker reference

[14]   Drucker describes a method and apparatus for improving access to current and past literatures and for selecting some or all of the search result based on the user's criteria. Drucker is more about "researching" databases for articles in the electronic regime, whereas the present invention is related to "retrieving" an article that has already been read, in hardcopy, by the readers. A user of Drucker's system may not result in any HITS, whereas a reader using the present invention always retrieves the article, because the pre-assigned tag uniquely identifies the article and allows retrieval. The reader of the present invention does not need to create any query on his own, since all the reader needs is the pre-assigned tag, which has been printed with the article. Drucker's users will need to generate appropriate queries or criteria in order to search the

databases, which may still return <u>without any hits</u>.

[15]   Moreover, the articles in Drucker are <u>not printed with any pre-assigned unique tag</u> in a <u>printed</u> publication. Drucker only discloses an electronic access, search and display system, without mention of "a printed article with a pre-assigned unique tag printed with it. Such distinction is not insignificant, since Drucker's system is a query-based search system, where its user may have <u>never</u> seen the article or read the article. To the contrary, the readers of the present invention <u>have already read the article in a printed media, observed the unique tag,</u> and <u>entered the unique tag associated with it</u> for the retrieval. No queries need to be generated and entered. The readers of the present invention are only interested in retrieving the article in the simplest, easiest and most efficient way. Drucker's system does not do that, nor can it.

[16]   In claims 1 and 10, the Examiner has not established a *prima facie* case of anticipation based on Drucker with respect to at least the following claim limitations.

[17]   *"assigning said at least one printed article with at least one tag;"*

[18]   Drucker, col. 4, lines 32-44, col. 8, lines 37-52, as cited by the Examiner is inapplicable and irrelevant. Here, Drucker's system does not assign a unique tag, e.g. LAT-11272001-B1-4, to the <u>printed</u> article <u>before publication,</u> as described in Specification, paragraph 37, page 7. Drucker's system here only describes search information set up by the user in identifying the database to search, or what information is presented to the user when notifying the user <u>after</u> the search is done. Drucker does not describe a tag assigned to the printed article <u>before publication in print of such article,</u> which can facilitate the subsequent retrieval by the reader. There is also no teaching of Drucker's articles being printed in publication with the unique tag.

[19]   *"publishing said at least one printed article in print with its corresponding tag;"*

[20]   Drucker, col. 6, lines 16-38, col. 8, lines 37-52, Fig. 6C, as cited by the Examiner is also inapplicable and irrelevant. Drucker does not describe that <u>the article and the tag</u> are <u>published in print.</u> Drucker, col. 6, lines 16-38, describes filtering of the search result based on a patient's chart and a user's search history, <u>all at the user's end.</u> It does not describe the publishing, <u>in print,</u> of the article with the tag, <u>at the system's end, all before the reader has read the printed article.</u> In col. 8, lines 37-52, Drucker describes the information to be presented to the user, when notifying the user after the search is conducted. No mention of any <u>publishing of the article in print with the tag, before a search is conducted,</u> is described by Drucker, here or anywhere in Drucker.

[21]   That Drucker does not assign the tag to be published with the article is further acknowledged by the Examiner in the Examiner's rejection of claim 9, paragraph No. 15, pg. 6 of the instant Office Action. There, the Examiner notes that Drucker does not specifically assign a default code, "said default code being published with said printed article when printed."

[22]   *"receiving a request from an Internet client, said request including said at least one tag;"*

[23]   Again, the Examiner's citation of Drucker, col. 3, lines 27-32, col. 7, lines 66-67, col. 8, line 1-5, is inapposite and irrelevant. Drucker's searches do not include any tag that is uniquely associated and printed with the article. As cited by the Examiner, Drucker's users here come up with their criteria in order to do the search, whereas the tag of the present invention has already been assigned and published with the printed article. Drucker's criteria are generated by the users and the criteria do not uniquely identify a printed article which has been read by the reader. As described before, the users of Drucker may end up with NO HITS if the criteria are not properly generated.

[24]   The present invention, quite to the contrary, guarantees the retrieval of an article identified by the unique tag, since that is how the system is initially set up and how the article is printed. The system of the present invention is not to do a "fishing expedition" based a query generated by the user, but to allow the reader to electronically retrieve with pinpoint accuracy a printed article by virtue of the unique printed tag. The distinctions are quite significant between Drucker and the present invention.

[25]   *"searching through said database to locate said printed article matching said at least one tag;"*

[26]   As discussed above, Drucker's search is a search of all relevant databases based on the query entered by its user. This is quite an arduous task, since the query must be conducted on each and every literature in the databases. On the other hand, the present invention only looks for the tag, which is already provided by the printed article and observed by the reader. As soon as the tags are matched, the article is located and can be transmitted to the reader of the present invention. Not so for Drucker, even if one or more article is found based on the query, the search still must go on throughout the databases. As such, retrieving an article based on the tag in the present invention is quite different from Drucker's query-based search, in terms of process and performance.

[27]   In light of the above discussion, Applicant respectfully submits that the Examiner has not established a *prima facie* case of anticipation. Therefore, Applicant respectfully requests that the rejection of claims 1 and 10 be withdrawn and allowance granted.

[28]   With respect to claims 2-8 and 11, which are dependent claims of claim 1 and 10, respectively, withdrawal of the rejections is also requested in light of the above discussion.

[29]   <u>REJECTIONS UNDER 35 USC SEC. 103</u>

[30]   Claims 9, 12, 15-17 are rejected under 35 USC Sec. 103(a) as being unpatentable over Drucker as applied to claims 1, 10 and further in view of Loeb, US Patent No. 6,014,641. Applicant respectfully traverses the rejections.

[31]   In claim 9, with respect to Drucker, Applicant respectfully directs the Examiner's attention to the above discussion as to why Drucker is inapplicable. Even if Drucker is combined with Loeb, the resulting system is still distinguishable from the present invention, since Drucker has been shown to be distinguishable from the independent claim of claim 9.

[32]   Additionally, with respect to Loeb, its use of the magazine ID, magazine name, publisher ID still does not uniquely identify a printed <u>article</u>. There is still no unique tag associated and <u>printed with each printed article</u>. There was thus no motivation for someone skilled in the art to modify Drucker to incorporate Loeb's feature, since such modification would not have improved Drucker's search query. Without contribution from Loeb, Drucker has already implemented such query systems. Loeb's teaching is to maintain magazine <u>subscription</u>, which is quite different from that of Drucker's improving the query search.

[33]   In view of the above, the Examiner's rejection of claim 9 is also inappropriate. Again, the Examiner has failed to establish a *prima facie* case of obviousness by relying on Drucker and Loeb. Withdrawal of the rejection and allowance is respectfully requested.

[34]   With respect to claims 12-17, Applicant respectfully directs the Examiner's attention to the above discussion. Withdrawal of the rejections and allowance is respectfully requested.

[35]   Claim 18 is rejected under 35 USC Sec. 103 (a) as being unpatentable over Drucker, Loeb and further in view of Walker, US Patent No. 6,449,616. Applicant respectfully traverses the Examiner's rejection.

[36]   Applicant has heretofore discussed the improper reliance on Drucker and Loeb by the Examiner with respect to the independent claim of claim 18. Therefore, Applicant respectfully submits that claim 18 should be patent over the cited references based on the discussion above re

Drucker and Loeb. Withdrawal of the rejection and allowance is respectfully requested.

[37] **Conclusion**

[38] Applicant has demonstrated that the Examiner has failed to establish *prima facie* cases of anticipation and obviousness. Withdrawal of the Examiner's rejections and granting of allowance is respectfully requested.
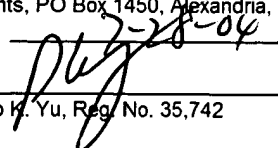
[39] The Examiner is encouraged to contact the undersigned to discuss any matter regarding the present application.

Respectfully Submitted,

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